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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,511	02/26/2004	Bruce C. Campbell	86927CPK	6480

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT PAPER NUMBER

1774

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/787,511

Applicant(s)

CAMPBELL ET AL.

Examiner

Betelhem Shewareged

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-26 is/are pending in the application.
- 4a) Of the above claim(s) 22-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-21 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response along with the Request for Continued Examination (RCE) filed on 08/28/2006 has been fully considered. Claims 1 and 21 are amended, claims 2 and 3 are canceled, claim 26 is added, and claims 1 and 4-26 are pending. (NOTE: Claims 22-25 are withdrawn from consideration as non-elected invention).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1 and 4-21 are rejected under 35 U.S.C. 102(a) as being anticipated by Wexler (US 6,695,447 B1) as evidenced by Landry-Coltrain et al. (US 6,497,941 B1).

4. Wexler discloses an ink jet recording element comprising a support, an ink carrier liquid receptive layer on the support, a dye trapping layer on the ink carrier liquid receptive layer and an ink transporting layer on the dye trapping layer (abstract). The dye trapping layer is equivalent to the claimed porous ink receptive layer. The combination of the ink carrier liquid receptive layer and the support is equivalent to the claimed porous support because the support of the **current invention** comprises an adjacent layer that is either paper or a voided extruded polymeric film that is extruded, including optional co-extrusion with additional underlying layers in the support, wherein the adjacent layer forms the upper surface of the support and is the porous layer contiguous or in contact with the image-receiving layer. Preferably, if the upper layer is coextruded, the coextruded portion also comprises at least 80%, preferably at least 90% of

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the thickness of the element (page 7, line 24 of current specification). The ink carrier liquid receptive layer and the support of Wexler are described in col. 5, line 19 thru col. 6, line 26, and the evidence has been shown in the reference of Landry-Coltrain. The dye trapping layer comprises polymeric particles having a particle size of 0.1-10um, a binder and mordant (col. 3, line 41 thru col. 4, line 58). The thickness of the dye trapping layer ranges from 2-50um (col. 5, line 15). With respect to the Bristow Test absorption value, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re Swinehart et al.*, 169 USPQ 226 at 229. Since the Wexler reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Response to Arguments

5. Applicant's argument is based on that Wexler fails to teach a single layer of ink receiving layer over the porous support, and a cellulosic paper or a synthetic non-woven fibrous sheet as the porous support. This argument is not persuasive because independent claims 1 and 21 recites **a single layer of ink receptive layer that is capable of holding all ink colorant in an ink composition**. However, the ink carrier liquid receptive layer of Wexler holds **only** the ink carrier of the ink composition, and the ink transporting layer **does not** hold ink colorant, thus similar to the claimed invention,

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Wexler teaches a single layer of dye trapping, which is equivalent to the claimed single layer of ink receptive layer. Furthermore, the claimed invention does not exclude any other layers. With respect to the support, the support of Wexler comprises plane paper, which is equivalent to the claimed cellulosic paper, and with respect to claims 1 and 4-21 the support is not limited to a single layer support.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. (US 6,902,268 B1) in view of Wexler (US 6,695,447 B1).

8. King discloses an ink jet recording medium comprising a single layer of fusible ink receiving layer and a substrate (col. 2, lines 20-26 and claim 1). The substrate comprises paper (col. 2, line 42). King does not teach fusible ink receiving layer as recited in claim 26.

9. Wexler teaches an ink jet recording element comprising a support, an ink carrier liquid receptive layer on the support, a dye trapping layer on the ink carrier liquid receptive layer and an ink transporting layer on the dye trapping layer (abstract). The dye trapping layer is equivalent to the claimed porous ink receptive layer. The dye trapping layer comprises polymeric particles having a particle size of 0.1-10um, a binder

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and mordant (col. 3, line 41 thru col. 4, line 58). The thickness of the dye trapping layer ranges from 2-50um (col. 5, line 15). With respect to the Bristow Test absorption value, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re Swinehart et al.*, 169 USPQ 226 at 229. Since the Wexler reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

10. King and Wexler are analogous art because they are from the same field of endeavor that is the ink jet recording medium art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the dye trapping layer of Wexler with the invention of King, upon fusing, to eliminate the air particle interfaces present in the original porous structure of the layer, and to form a non-scattering substantially continuous layer which raises image density (col. 3, lines 41-52 of Wexler).

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

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12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B.S.
September 28, 2006.


BETELHEM SHEWAREGED
PRIMARY EXAMINER